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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,348	07/03/2003	Gary Sederholm	IOI-454	7308
7590 12/01/2005 JOHNATHAN D. FEUCHTWANG ZIMMER TECHNOLOGY INC. 150 NORTH WACKER DRIVE SUITE 1200 CHICAGO, IL 60606			EXAMINER BLANCO, JAVIER G	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/613,348

Applicant(s)

SEDERHOLM ET AL.

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 4-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' cancellation of claim 3 in the reply filed on September 6, 2005 is acknowledged.
2. Applicants' addition of claims 21 and 22 in the reply filed on September 6, 2005 is acknowledged.
3. Applicants' amendment of claims 1, 4, 9, and 14-16 in the reply filed on September 6, 2005 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 16-20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - a. Regarding independent claim 16, newly added limitation "the proximal body being positioned around the stem" (see line 4) lacks antecedent basis. Claims 17-20 and 22 depend on claim 16.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 9, 10, 13-19, 21, and 22 are rejected, as best understood, under 35 U.S.C. 102(e) as being clearly anticipated by Doubler et al. (US 6,692,530 B2).

Referring to Figures 1 and 4-6, Doubler et al. disclose a modular hip implant comprising a stem (11) extending from a proximal end to a distal end; a neck (46/41 and 16 collectively) being rotationally adjustable (capable of being adjusted) about the stem; a proximal body (20) being rotationally and axially adjustable (capable of being adjusted) about the stem, and having a threaded section (threads 51); an expansible collet (40) positionable (capable of being positioned) between the stem and proximal body; and a locking member (13) having threads *adapted to engage* (emphasis added to functional language) the threaded section to lock the proximal body and collet together and to the stem. Said locking member has a ring shape in cross-section.

### ***Response to Arguments***

8. With regards to the 102(e) rejection based on Doubler et al. (US 6,692,530 B2), Applicant's arguments filed September 6, 2005 have been fully considered but they are not persuasive.

a. Regarding claim 9, contrary to Applicants arguments, the limitation "the proximal body is positioned around the stem" is not disclosed in claim 9.

b. Regarding claim 16, newly added limitation "the proximal body being positioned around the stem" (see line 4) lacks antecedent basis, rendering claim 16 indefinite as to the scope of the invention (see 112 1<sup>st</sup> paragraph rejection above).

9. Claims 1, 2, and 4-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Daniels et al. (US PGPUB No. 2004/0122525). Emphasis (i.e., italics) will be added to the functional language (e.g., “adapted to engage”; “to lock”) and “capable of” (e.g., “expansible”; “movable”) language.

Referring to Figures 1-4, 7-10, and 12, Daniels et al. disclose a modular hip prosthesis (Figure 1: prosthesis 10; Figure 4: prosthesis 50), comprising:

- (i) An elongated stem (Figure 1: stem 18; Figure 4: stem 52) extending from a proximal region (Figure 1: post 28, having tapered shank 32; Figure 4: proximal stud 56) to a distal region;
- (ii) A proximal body (**first interpretation:** as shown in Figure 10, proximal portion of body taper component 90; **second interpretation:** as shown in Figures 7, 8, 10, and 11, keyed component 94 + interdigitating component 106) having a bore (Figure 8: bore 91) with a threaded section (**first interpretation:** as shown in Figure 8 and disclosed in paragraph 0064, internal threads 92; **second interpretation:** as shown in Figures 7, 8, 10, and 11, interdigitating component 106) and being removably *connectable* to the stem (**note:** with regards to claims 9 and 16, “sleeve component 14” could alternatively be considered to be the “proximal body”);
- (iii) A neck (Figure 1: neck 12; Figure 4: neck 62) *connectable* to the proximal region of the stem;
- (iv) An *expansible* collect (**first interpretation:** as shown in Figure 10, distal portion of body taper component 90; **second interpretation:** as shown in Figures 8 and 10, the entire length of body taper component 90) *positionable* between the stem and proximal body; and
- (v) A locking member (**first interpretation:** as shown in Figure 10, keyed component 94 having the shape of a cylindrical nut with external threads; **second interpretation:** as shown in Figure

12, interdigitating surface 124) having threads (Figure 10: external threads 96 of keyed component 94; Figure 12: interdigitating surface 124) *adapted to engage* the threaded section *to lock* the proximal body and collect together and to the stem, wherein the neck is *movable* with respect to the proximal body, until being locked into position by the locking member (see entire document). Each of the components may be embodied as separate components (see page 4, paragraph 0053). The components may be connected to each other by taper-fit (see page 5, paragraph 0055 and paragraph 0064).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Ahrens et al. (DE 36 09 120).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

November 25, 2005



**CORRINE McDERMOTT**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**